



Practitioner's Docket No. 1822/113

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Nissum Benvenisty

Application No.: 09/918,702  
Filed: July 21, 2001  
For: Directed Differentiation of Embryonic Stem Cells

Group No.: 1632  
Examiner: Crouch, D.

Corres. and Mail  
**BOX AF**

**SUBMISSION UNDER  
37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUBMISSION OF EXECUTED DECLARATION IN SUPPORT  
OF APPLICANT'S RESPONSE TO FINAL REJECTION**

A response to the final rejection was mailed on March 17, 2005 and included an unexecuted Declaration in Support of Applicant's Response by Dr. Nissim Benvenisty. Submitted herewith is the executed Declaration in Support of Applicant's Response.

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

(When using *Express Mail*, the *Express Mail* label number is *mandatory*;  
*Express Mail* certification is *optional*.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. § 1.8(a)

☒ with sufficient postage as first class mail.

37 C.F.R. § 1.10\*

☐ as "Express Mail Post Office to Addressee"

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**TRANSMISSION**

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Signature

Date: March 24, 2005

Barbara J. Carter

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

1. Enclosed is:

- A. Executed Declaration of Inventor in Support of Applicant's Response
- B. Copy of response to final rejection mailed on March 17, 2005.

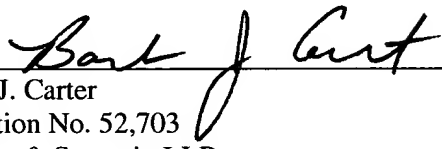
**STATUS**

2. Applicant is a small entity. A statement was already filed.

**FEE DEFICIENCY**

3. If any additional extension and/or fee is required, charge Account No. 19-4972.
- If any additional fee for claims is required, charge Account No. 19-4972.

Date: March 24, 2005

  
\_\_\_\_\_  
Barbara J. Carter  
Registration No. 52,703  
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125 Summer Street  
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# Docketed

B

Practitioner's Docket No. 1822/113

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Nissum Benvenisty

Application No.: 09/918,702

Group No.: 1632

Filed: July 21, 2001

Examiner: Crouch, D.

For: Directed Differentiation of Embryonic Stem Cells

**RESPONSE UNDER  
37 C.F.R. § 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP**

COPY

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Alexandria, VA 22313-1450

### AMENDMENT OR RESPONSE AFTER FINAL REJECTION--TRANSMITTAL

#### CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

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Signature

Date: March 17, 2005

Barbara J. Carter

(type or print name of person certifying)

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1. Transmitted herewith is an amendment after final rejection (37 C.F.R. 1.116) for this application. Also enclosed is:

- A. Declaration of Inventor in Support of Applicant's Response
- B. Exhibits A-E

### STATUS

2. Applicant is a small entity. A statement was already filed.

### EXTENSION OF TERM

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

### FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col. 1) Claims Remaining After Amendment		(Col. 2) Highest No Previously Paid For	(Col. 3) Present Extra	SMALL ENTITY Rate	Addit Fee
Total	26	Minus	50	= 0	x \$25 =	\$0
Indep	9	Minus	7	= 2	x \$100 =	\$200
First Presentation of Multiple Dependent Claim					+ \$180 =	\$0
Total Addit. Fee						\$200

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3,

\*\* If the "Highest No. Previously Paid For" IN THIS SPACE (Column 2, Row 1) is less than 20, enter "20".

\*\*\* If the "Highest No. Previously Paid For" IN THIS SPACE (Column 2, Row 2) is less than 3, enter "3".

The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col. 1 of a prior amendment or the number of claims originally filed.

Total additional fee for claims required \$200.00

### FEE PAYMENT

5. Attached is a check in the amount of \$200.00.

A duplicate of this paper is attached.

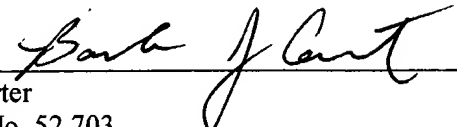
**FEE DEFICIENCY**

6.

If any additional extension and/or fee is required, charge Account No. 19-4972.

If any additional fee for claims is required, charge Account No. 19-4972.

Date: March 17, 2005

  
\_\_\_\_\_  
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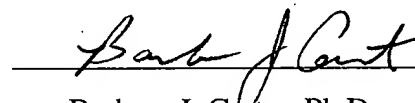
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Benvenisty, N. Attorney Docket: 1822/113  
Serial No.: 09/918,702 Art Unit: 1632  
Filing Date: July 31, 2001 Examiner: Crouch, D.  
Invention: **Directed Differentiation of Embryonic Stem Cells** Date: March 17, 2005

\*\*\*\*\*

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service in an envelope as first class mail with sufficient postage addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 17, 2005.

  
Barbara J. Carter, Ph.D.

\*\*\*\*\*

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE UNDER 37 CFR §1.116 – EXPEDITED PROCEDURE –  
TECHNOLOGY CENTER 1600, ART UNIT 1632  
RESPONSE TO OFFICE ACTION OF DECEMBER 17, 2004**

Dear Sir:

Applicant thanks the Examiner for the interview of March 3, 2005 to discuss the pending claims and the cited art. Applicant respectfully submits this response, with a Declaration under 35 USC § 1.132 by Dr. Benvenisty and his *curriculum vita* (Exhibit A), in reply to the Office Action of December 17, 2004, and asks that the following amendments be entered and the arguments be considered.

**INDEX**

**Amendments to the Claims** begin on page 2 of this paper.

**Remarks/Arguments** begin on page 10 of this paper.